

### **REMARKS**

The Office Action mailed November 28, 2004 has been reviewed and the comments of the Patent and Trademark Office have been considered. Claims 1-20, 22-49, 61, 66-70, 140, 142, and 143 were pending in the application. Since none of the claims have been amended or cancelled, claims 1-20, 22-49, 61, 66-70, 140, 142, and 143 are pending in the application and are presented for consideration.

This reply does not change the pending claims. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, are presented, with an appropriate defined status identifier.

In the Office Action, claims 1-20, 22-49, 61, 66-70, 140, 142, and 143 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 6,131,810 to Weiss et al. (hereafter "Weiss") in view of U.S. patent 5,870,721 to Norris (hereafter "Norris") and further in view of U.S. patent 5,826,243 to Musmanno et al. (hereafter "Musmanno"). Applicants respectfully traverse this rejection for at least the following reasons listed in section 7 below.

#### **1. REAL PARTY IN INTEREST**

The real party in interest is the current assignee of the patent application, Cathleen Noland.

#### **2. RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences.

#### **3. STATUS OF CLAIMS**

Claims 1-20, 22-49, 61, 66-70, 140, 142, and 143 are pending in the application. Claims 21, 50-60, 62-65, 71-139, and 141 are cancelled. Claims 1-20, 22-49, 61, 66-70, 140, 142, and 143 are rejected and are submitted for reconsideration.

#### **4. STATUS OF AMENDMENTS**

The present application is under a rejection prior to filing an Request for Continued Examination (RCE) (See Office Action mailed November 28, 2004).

**5. SUMMARY OF CLAIMED SUBJECT MATTER**

The invention of independent claim 1 is directed to a computer implemented method of providing a client with an integrated financial management account, the integrated financial management account including an investment component linked to a loan component. (See page 11, first full paragraph). The specification discloses receiving application data for the integrated financial management account online directly from the client. (See page 11, first full paragraph; page 13, first and second full paragraphs; page 16, third paragraph).

The specification discloses setting up the integrated financial management account with investment component data and loan component data associated with an account file at the time of setting up of the integrated financial management account. (See page 14, first and second paragraphs). The specification discloses linking the loan component data to the investment component data in the step of setting up the integrated financial management account. (See page 23, last paragraph; page 26, last paragraph to page 27, line 5). The specification discloses that contemporaneous with the step of setting up the integrated financial management account in the account file, associating an investment asset to the investment component data in the account file based on the linking of the loan component data to the investment component data, wherein the client is credited with the investment asset in the investment component of the integrated financial management account. (See page 23, last paragraph; page 26, last paragraph to page 27, line 5; page 28, last paragraph).

The specification further discloses qualifying the client for a loan in the loan component of the integrated financial management account and recording the qualification in the account file; and after successful loan qualification, disbursing the proceeds of the loan component into the investment component by storing a value of the proceeds in the investment component data in the account file, or after unsuccessful qualification, removing the association of the investment asset to the investment component data in the account file. (See page 27, first full paragraph; page 30, last paragraph).

The process of purchasing insurance products including portfolio insurance (as recited in claims 22, 141, and 142) as a part of the opening of the integrated financial management account is disclosed at least at page 24, second full paragraph of the specification.

The inventions of independent claim 70 and 140 are also supported at least by the same portions of the specification discussed with respect to claim 1.

It should be noted that the above described support in the specification does not comprise the complete listing of support in the specification for the features mentioned above. The features mentioned above are also disclosed in various other parts of the specification as would be apparent to one skilled in the art from the disclosure of the specification.

**6. GROUND OF REJECTION TO BE RECONSIDERED**

The grounds of rejection to be reconsidered are:

A. the rejection of claims 1-20, 22-49, 61, 66-70, 140, 142, and 143 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 6,131,810 to Weiss et al. (hereafter “Weiss”) in view of U.S. patent 5,870,721 to Norris (hereafter “Norris”) and further in view of U.S. patent 5,826,243 to Musmanno et al. (hereafter “Musmanno”).

**7. REMARKS**

A. Claims 1-20, 22-49, 61, 66-70, 140, 142, and 143 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 6,131,810 to Weiss et al. (hereafter “Weiss”) in view of U.S. patent 5,870,721 to Norris (hereafter “Norris”) and further in view of U.S. patent 5,826,243 to Musmanno et al. (hereafter “Musmanno”). Applicants respectfully traverse this rejection for at least the following reasons.

**I. Independent Claims 1, 70, and 140**

***1. Neither Weiss, Norris, nor Musmanno disclose all the features recited in the pending independent claims***

Each of the independent claims 1, 70, and 140 recite, *inter alia*, the following features that are not disclosed or suggested by the applied prior art: (a) (i) setting up an integrated financial management account with (ii) application data received online; and (b) (i) *contemporaneous* with setting up an integrated financial management account, associating an investment asset to the investment component data based on (ii) linking the investment component data to the loan component data of the integrated financial management account.

As acknowledged in the Office Action, Weiss does not show either (a) (ii) or (b) (i) or (ii). That is, Weiss does not show setting up an integrated financial management account online, nor does it show *contemporaneous* with setting up of the integrated financial management account associating an investment asset to an investment component data in the account based on the linking of the loan component data to the investment component data (all of these claimed features occur contemporaneous with the online setting up of the integrated financial management account). The cited portions of Weiss (claims 1, 5, and 8 as well as col. 4, lines 37-39 and col. 14, lines 58-67) relate to a bank employee opening an integrated account and separate processes for investment components and loan components. There is simply no disclosure or suggestion in Weiss of the claimed *contemporaneous* with setting up of the integrated financial management account associating an investment asset to an investment component data in the account based on the linking of the loan component data to the investment component data.

To cure this deficiency, the office action relies on **Norris** for disclosing receiving application data online. However, neither does Norris disclose or suggest the claimed *contemporaneous* with setting up of the integrated financial management account associating an investment asset to an investment component data in the account based on the linking of the loan component data to the investment component data.

The Office Action then alleges that Norris' disbursal of loan proceeds corresponds to the claimed investment component of the applicant's amount. *First*, there is simply no disclosure in Norris with respect to this feature. The Patent Office (PTO) has the burden of proving each of the claimed features is shown by the prior art. An apparent allegation that claimed subject matter is "obvious" (as here alleged presumably in combination with Weiss) requires a positive, concrete teaching in the prior art, such as would lead a person skilled in the art to choose the claimed combination from among many that might be comprehended by broad prior art teachings. The PTO's review court has made it very clear that silence in a reference is hardly a substitute for clear and concrete evidence from which a conclusion of obviousness might justifiably flow. See, e.g., *Application of Burt*, 356 F.2d 115, 121 (CCPA 1966).

If, on the other hand, the PTO intended to indicate that this feature was somehow inherent in the cited reference, it should be noted that the standard for inherency requires that the feature be *necessarily present* in the prior art and not simply that it may occur or be present, i.e., be broadly included in a general or non-specific prior art teaching. See MPEP 2112 and the cases cited therein including *In Re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82 (CCPA 1981) (to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill). Accordingly, applicants submit that at least this recited feature is not disclosed by the applied prior art.

*Second*, even if this allegation based on Norris were correct, it still does not disclose that the claimed *contemporaneous* with setting up of the integrated financial management account associating an investment asset to an investment component data in the account based on the linking of the loan component data to the investment component data since it discloses disbursing the proceeds of the loan to the investment account (after loan approval after the application process) while the claimed invention provides for associating the investment asset contemporaneous with the setting up of the integrated financial management account (i.e., even *before* a loan is approved or disbursed).

Finally, the office action relies on **Musmanno** for disclosing sub-accounts associated with a master account. However, even if Musmanno discloses sub-accounts associated with a master account, there is no positive or concrete teaching in Musmanno regarding any of the features (a) (i) and b(i) and b(ii) discussed above.

Therefore, all the applied prior art, even if properly combinable, do not disclose several of the features recited in the pending independent claims. Accordingly, the pending independent claims 1, 70, and 140 are patentable over the applied prior art.

## **2. Examiner's Interpretation of the Claims is not Reasonable**

Applicants maintain (and have maintained throughout the prosecution of the present application) that the Examiner's interpretation of the prior art to read on the claimed invention in the claims is not a reasonable interpretation of the claims. Claims under

examination are to be given a broad reasonable interpretation consistent with the specification. In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000) (emphasis added). The claim interpretation must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 15 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). Several interpretations in the Office Action are neither consistent with the plain language of the claims, the specification or the file history of the present application nor the interpretation of those skilled in the art. In particular, the examiner's interpretations based on Norris and Musmanno on pages 3 and 4 of the office action ignore the plain meaning of the claimed terms (for example, contemporaneous) as well as the specification and the file history so that these interpretations are out of the bounds of reasonableness. If the claims are reasonably interpreted, the rejections based on Weiss, Norris, and Musmanno must fail.

## **II. Dependent Claims**

Dependent claims 2-20, 22-49, 61, 66-69, 142, and 143 depend from one of independent claims 1, 70, and 140 and are allowable for at least the same reasons, as well as for further patentable features recited therein.

Claims 22, 141, and 142 recite *contemporaneous* with setting up the integrated financial management account, associating a portfolio insurance selected by a client with an insurance component of the integrated financial management account. No such contemporaneous selection of portfolio insurance (in combination with the investment and loan components) is disclosed or suggested by the applied prior art and provides another reason for the patentability of these claims.

With respect to the dependent claims 2-20, 23-49, 61, and 66-69, the office action states that these claims are rejected based on "combined disclosures of Musmanno, Norris and Weiss or official notice is taken...." See last line on page 5 of the office action. Applicants respectfully request the examiner to identify which features have been rejected based on official notice. Applicants disagree with such official notice and respectfully request the examiner to provide a reference that discloses these features as required by MPEP 2144.03.

**8. CONCLUSION**

For the foregoing reasons, it is submitted that the applied rejections are erroneous, and withdrawal of the applied rejections is respectfully requested. Applicants submit that the application is now in condition for allowance. If there are any questions regarding the application, or if an examiner's amendment would facilitate the allowance of one or more of the claims, the examiner is courteously invited to contact the undersigned attorney at the local telephone number below.

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge deposit account No. 19-0741 for any such fees; and applicants hereby petition for any needed extension of time.

Respectfully submitted,

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